

### REMARKS

The above preliminary amendments and following remarks are submitted in accordance with a Request for Continued Examination filed on even date and in response to the Final Official Action of the Examiner mailed on January 5, 2006. Having addressed all objections and grounds of rejection claims 1-25, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

On October 12, 2005, the Examiner mailed an official action which was prematurely made final. The action was prematurely final, because it rejected claims 11-20 on entirely new grounds involving the citation and application of new prior art. Applicants responded in part by arguing the prematurity of the final action.

Apparently, the Examiner has found Applicants' argument compelling. However, instead of complying with MPEP 706.07(d) which specifically provides for the withdrawal of premature finality of an official action, the Examiner appears to have created his own procedure. In the pending official action the Examiner states at paragraph 2:

This office action replaces office action dated 10-12-2005 and corrects Applicants (sic) record. See new office action below.

Applicants strongly object to this blatant disregard of controlling law. The Examiner has not and cannot cite any

authority for "replacing" a previous office action to which Applicants have already responded. Furthermore, the Examiner has not and cannot present any authority permitting him to "correct Applicants' record" in this manner.

Apparently, the Examiner has entered the official action of October 12, 2005 and withdrawn the finality thereof, because the Examiner has referred to the substance of the previous office action in the pending office action. Furthermore, Applicants' response thereto was made as a matter of right, because it is a response to a non-final office action. In addition, the Examiner has entered Applicants' response into the record, because he also references the substance of this document in the pending official action. As a result, instead of the Examiner's clearly statement of paragraph 2, the official action of October 12, 2005 and response thereto have become part of the permanent prosecution history of the subject application.

In addition, because the Examiner's rejection of claims 1-20 (including unamended claims 11-15) presented in his official action of August 19, 2004, was withdrawn in favor of the new grounds of rejection of October 12, 2005 in view of Applicants' arguments, the Examiner has shown on the record that he deems claims 11-15 patentable over the rejection made on August 19, 2004. It is respectfully submitted that Applicants are entitled to a full explanation for any suggestion by the Examiner that he

may have changed his mind about his rejections of August 19, 2004.

Therefore, claims 11-15 have now been finally rejected as anticipated under different grounds of rejection in view of different prior art from the rejection of October 12, 2005 and subsequently argued by Applicants. Because claims 11-15 have never been amended, the Examiner's statement of paragraph 8 of the pending official action is clearly erroneous. The Examiner states:

Applicant's amendment necessitated the new ground(s) of rejection presented in this office action.  
Accordingly, *THIS ACTION IS MADE FINAL*. See MPEP 706.07(a).

As a result, the finality of the pending official action is premature, because claims 11-15 now stand finally rejected on grounds of rejection that are new as a matter of record.

Applicants are extremely interested in having their claimed invention properly examined in view of the most pertinent prior art. However, Applicants are particularly interested in having their claimed invention examined in accordance with controlling law. It is respectfully requested that the Examiner conduct his examination in accordance with controlling law.

The Examiner has prematurely issued the pending official action as final. He has done so, even though he has rejected all pending claims on newly cited prior art. In support of this premature finality, the Examiner clearly erroneously states:

Applicant's amendment necessitated the new ground(s) of rejection presented in this office action.

This statement is clearly erroneous because claims 11-15 have never been amended. Yet, the Examiner has now finally rejected claims 11-15 under a newly cited ground of rejection in accordance with newly cited prior art. The Examiner has presented no explanation of how unamended claims 11-15 have necessitated the new grounds of rejection.

Similarly, claims 16-20 have previously been amended only to attend to certain editorial matters. Claims 16-20 clearly have not been amended in a manner to "necessitate the new ground of rejection presented in this office action" as stated by the Examiner. Therefore, the finality of the pending official action should be withdrawn as based upon clearly erroneous findings of fact.

Claims 11-20 have been newly rejected under 35 U.S.C. 102(e) as being anticipated by newly cited U.S. Patent No. 6,721,727, issued to Chau et al (hereinafter referred to as "Chau"). This ground of rejection is respectfully traversed as to claims 11-20 for the following reasons.

The standard for a finding of anticipation during the examination process is specified in MPEP 2131, which provides:

**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).  
**"The identical invention must be shown in as complete detail as is contained in the ... claim."** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection of claims 11-20 as anticipated by Chau is respectfully traversed because Walsh has not met the requirement that "the identical invention must be shown in as complete detail as is contained in the ... claim".

Chau is dedicated to showing how to construct and search a relational data base containing XML documents. This is apparent from the title, "XML DOCUMENT STORED AS COLUMN DATA", and from the abstract which begins:

A technique is provided for creating metadata for fast search of XML documents stored as column data.

That means that Chau's attention is limited to storing data from an XML message into the relational data base and retrieving data from that relational data base for packing into an XML message. In other words, Chau is limited to transferring data from the XML message to the relational data base and transferring data from the relational data base to an XML message. The important thing,

however, is that Chau has no interest in conversion between XML and other formats. Chau receives data in XML document format, stores data in XML document format, searches data in XML document format, and communicates in XML document format.

Applicants' invention, on the other hand, establishes an interface from a legacy data base management system (as distinguished from data base) to a user terminal using XML messages. Applicants describe the Field of the Invention (see specification at page 1, lines 11-13) as:

The present invention generally relates to data base management systems and more particularly relates to enhancements for providing an interface between a legacy data base management system and Internet servers employing XML (extensible markup language) protocol

The initiating transfer between a user and a data base management system involves the request of a "service". This service request may include appended input parameters but is primarily a request of the data base management system to execute one or more data base management functions which are presented to the data base management engine as an ordered sequence of command language script.

The result of honoring the service request by the data base management system is in a legacy format which is certainly not compatible with XML. Therefore, to complete the transaction, it is necessary to convert the service request result into an XML message for transfer back to the user terminal.

Thus, Chau searches a data base of XML documents whereas Applicants converts service request results from a legacy data base which are not in XML format into an XML message from transfer to the service requestor.

Claim 11 is an independent method claim having four steps. The first step requires transferring a service request. Chau has no service request. Therefore, Chau cannot transfer a service request. As if to add confusion, the Examiner cites Chau, column 4, lines 15-24, which says nothing of transferring a service request stating:

A client computer 102 typically executes a client application and is coupled to a server computer 104 executing one or more server software. The server software may include an XML system 110. The server computer 104 also uses a data store interface and, possible, other computer programs, for connecting to the data sources 106. The client computer 102 is bi-directionally coupled with the server computer 104 over a line or via a wireless system. In turn, the server computer 104 is bi-directionally coupled with data accesses 106. (Emphasis added)

The citation does not even obliquely mention transferring a service request over a publicly accessible digital data communication network, as claimed.

In paragraph 3 of the pending official action, the Examiner repeats the portion of the citation which is emphasized above, and then bafflingly states that it 'clearly teaches "service request"'. Certainly, this does not meet the requirements of MPEP 2131 to "show the identical invention in as complete detail as in the

claim". Telephones may be "bi-directionally coupled" without having the claimed "service request".

Because Chau has no service request, it cannot process the service request as is limiting of the second step. As a result, the Examiner again simply recites Fig. 1 and column 4, lines 15-24.

The third step of claim 11 involves converting the response into an XML document. Chau has no such non-XML response and no need for such a conversion as explained above. Therefore, the Examiner cites Chau, column 3, lines 15-21, which generally discusses packing data into a data base. However, there is no conversion because Chau needs no conversion. All data is handled as XML documents.

The fourth step of claim 11 is limited by transferring the XML document produced by the third step via the publicly accessible digital data communication network. Because Chau has no such XML document produced, he cites column 5, lines 50-52, which simply makes an off-hand reference to the Internet. The citation says nothing of the claimed "transferring" step.

Claim 11 has four steps. Chau has none of these steps. Therefore, the rejection of claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 12 depends from claim 11 and further limits the conversion facility. Chau has no such conversion facility and has no need for same. Instead of admitting this fact, the Examiner



again cites column 3, lines 15-21, which merely discusses packing XML documents into a data base. The rejection of claim 12 is respectfully traversed.

Claim 13 depends from claim 12 and further limits the Output Definition Table. Chau has no Output Definition Table. Therefore, Chau cannot have the further structure which limits the Output Definition Table. The rejection of claim 13 is respectfully traversed.

Claim 14 depends from claim 13 and further limits the conversion process. Chau has no such conversion process. Therefore, Chau cannot have the further limitations. The Examiner again cites Chau, column 3, lines 16-21. As is clear from this citation, it relates only to packing XML documents into a relational data base of XML documents. The rejection of claim 14 is respectfully traversed.

Claim 15 depends from claim 14 and further limits the publicly accessible digital data communication network. Chau does not have the limitations of the claims from which claim 15 depends. Therefore, Chau cannot meet these further limitations. The rejection of claim 15 is respectfully traversed.

Claim 16 is an independent apparatus claim having four "means-plus-function" claim elements. As such, it is to be examined in accordance with MPEP 2181 et seq. Though Chau off-handedly mentions the Internet at the cited column 5, lines 50-52, it says

nothing of the claim limitation of "means for transmitting an XML document". Chau has no "service request" and therefore does not have the "processing means" to process the claimed "service request". As explained above in detail, not only does Chau not have a "converting means", it has no need for a "converting means". Chau also has no "sending means". Therefore, the rejection of claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 17 depends from claim 16 and further limits the "processing means". Chau has no "processing means", so it cannot have the further structural limitations to the "processing means". The rejection of claim 17 is respectfully traversed.

Claim 18 depends from claim 17 and is further limited by a "defining means" for creating the converted response. Chau has no "service request", no "processing means" for processing the service request", no response generated by the processing of the service request, and therefore, has no "defining means" to define the response. The rejection of claim 18 is respectfully traversed.

Claim 19 depends from claim 18 and further limits the "transmitting means". Chau does not have the "transmitting means" as claimed. Therefore, it does not have the further limitations of claim 19. The rejection of claim 19 is respectfully traversed.

Claim 20 depending from claim 19 and adds the further limitation of the "defining means" being stored in the "storing

means". Chaus has neither the of these elements. Therefore, it cannot have the further limitations of claim 20. The rejection of claim 20 is respectfully traversed.

Claims 1-10 and 21-25 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,721,727, issued to Walsh et al (hereinafter referred to as "Walsh"). This ground of rejection is respectfully traversed as to claims 1-10 and 21-25 for the following reasons.

Specifically, Applicants' invention as disclosed and claimed requires a legacy enterprise data base management system which produces a response to a service request wherein the requestor anticipates the service request to produce an XML result and wherein the response generated by the enterprise data base management system is in a legacy format, and not in XML. As a result, the claimed invention requires structure to convert the "non-XML" response into an XML message.

Walsh, on the other hand, is concerned with converting non-XML inputs to XML for processing and storage and converting XML outputs to a non-XML format. Fig. 1b of Walsh, cited by the Examiner many times, clearly shows that web browser 124 communicates only in HTML/HTTP. Conversion to XML is required on input to enable the user to communicate with the system. Conversion from XML to HTML/HTTP is similarly required on output to communicate with browser 124.

Surely, the Examiner can distinguish between Applicants' production of a non-XML response to be converted into XML and Walsh's production of an XML output to be converted into a non-XML format. Walsh states in the Abstract the theme which is repeated throughout the disclosure stating:

A front-end interface converts the output XML documents to output HTML forms.

This should be compared with Applicants' claim language (from claim 1, for example) requiring:

....converting said response into said XML document....

Because Walsh produces an XML output which is converted from XML and Applicants require production of a non-XML output which is converted to XML, Walsh cannot possibly have the claimed structure as explained below in detail.

Specifically with regard to claim 1, the "response" and "conversion facility" make it absolutely explicit that the "response" is not compatible with the XML format and the "conversion facility" converts this response into an "XML message" for transfer back to the requesting user terminal.

Compare this with Walsh which converts "the output XML documents to output HTML forms". Therefore, Walsh does not have a "conversion facility" for converting non-XML responses into XML format, because the output documents are generated in XML. To make this distinction even more explicit, claim 1 has been amended to require that the input service request is located in an XML

document which also is converted. The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and further limits the "conversion facility" of claim 1. Walsh has no such "conversion facility". Therefore, it cannot have the limitations of claim 2 which further limit this structure. The rejection of claim 2, and any claim depending therefrom, is respectfully traversed.

Claim 3 depends from claim 2 and further limits the "conversion facility" of claim 1. Walsh does not have the "conversion facility" as explained above. Therefore, it cannot have the limitations of claim 3 which further limit this structure. The rejection of claim 3, and any claim depending therefrom, is respectfully traversed.

Claim 4 depends from claim 3 and further limits the "conversion facility" of claim 1. Walsh does not have the "conversion facility". Therefore, it cannot have the limitations of claim 4 which further limit this structure. The rejection of claim 4, and any claim depending therefrom, is respectfully traversed.

Claim 5 depends from claim 4 and further limits the "conversion facility" of claim 1. Walsh does not have the "conversion facility" as explained above. Therefore, it cannot have the limitations of claim 5 which further limit this structure. The rejection of claim 5, and any claim depending therefrom, is respectfully traversed.

Claim 6 is an independent apparatus claim having three basic elements. The second element of claim 6 is "a data base management system having an internal format different from XML". In support of his rejection, the Examiner cites Fig. 1b which shows that virtually all transfers within the system are via XML documents (see elements 102, 106, and 113) except the interface with web browser 124 which is indicated as HTML/HTTP. Thus, Walsh cannot meet this limitation.

The third element of claim 6 is the Output Definition Table which converts the response into an XML document. As explained above, the output of Walsh is in XML format. It does not need to be converted to XML as claimed.

In paragraph 3 of the pending official action, the Examiner states:

....the Examiner consider (sic) "mappings between the XML format and legacy formats" (Walsh et al. Col. 10, lines 1-13) reads On "a conversion facility for converting non-XML responses into XML format". (emphasis added)

This statement by the Examiner specifically makes Applicants' point. Walsh "mappings between the XML format" (i.e., input to conversion is XML format) and Applicants "converting non-XML responses" (i.e., input to conversion is non-XML format). Surely, the Examiner can see the inconsistency of his own logic.

The rejection of claim 6, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to show anticipation as defined by MPEP 2131.

Claim 7 depends from claim 6 and is further limited by "Document Type Definition (DTD) which defines a format of said XML document". The XML document is the response, which has been converted from the legacy format. Again the Examiner cites the same material from Walsh which shows that Walsh explicitly cannot meet this limitation. The rejection of claim 7, and any claims depending therefrom, is respectfully traversed.

Claim 8 depends from claim 7 and is further limited by "a repository within said data base management system for storage of said Output Definition Table". Clearly, Walsh cannot meet this limitation. Therefore, the Examiner confusingly again cites the same portions of Walsh, which are irrelevant to the claimed element. The rejection of claim 8 is respectfully traversed.

Claim 9 depends from claim 8 and is further limited by "a window for user activation of said Output Definition Table". Walsh has no "window"; Walsh has no such user accessible "Output Definition Table"; and Walsh has no need for either of these. Therefore, the Examiner again cites the same portions of Walsh, which have nothing to do with the claimed limitations. The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and further limits the claimed network element. Because Walsh does not have the claimed network element, it cannot meet this further limitation. Nevertheless, the Examiner cites the same material from Walsh saying nothing of the

claimed "Internet". The rejection of claim 10 is respectfully traversed.

For whatever reason, the Examiner at pages 13-15 discusses the relationship between Walsh and claims 16-20, even though claims 16-20 have not been rejected as anticipated by Walsh. In fact based upon the current record, it is assumed that the Examiner has found claims 16-20 to be patentable over Walsh. Therefore, Applicants respectfully object to the discussion by the Examiner of the relationship between Walsh and claims 16-20.

With regard to claim 21, the Examiner again ignores the requirement of MPEP 2131 requiring that "the identical invention must be shown in as complete detail as is contained in the ... claim". Instead, he again cites Figs. 1b, 2, and 4, along with column 9, lines 51-67, of Walsh which shows none of the claimed elements. In fact these citations specifically show that Walsh cannot anticipate claim 21. Even though Fig. 1b clearly shows that all communication with web browser 124 is in HTML/HTTP, the Examiner clearly erroneously alleges that this shows the claimed "transfer facility for transferring the XML message from the legacy data base management system to the user terminal". Similarly, the other four claimed elements of claim 21 are not shown "in as complete detail as is contained in the claim" as specifically required by MPEP 2131. The rejection of claim 21, and all claims depending therefrom, is respectfully traversed.



Claim 22 depends from claim 21 and adds further structure utilized in the conversion of the claimed first response from non-XML into XML format. As explained above, Walsh does not perform this conversion, because the output generated by Walsh are already in the form of an XML document. Therefore, Walsh cannot have the further limitations of claim 22. The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and is further limited by a "repository" for storage of the "ordered sequence of command language script" utilized to honor the service request. Walsh has none of this structure. The rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and is further limited by "a window for user activation of the XML message at said user terminal". As the Examiner is fully aware, Walsh discloses no window, as claimed; no user activation of the XML message; and no XML message at all at the user terminal. It is deemed disingenuous for the Examiner to continue to cite the same material (i.e., Figs. 1b, 2, 4, along with column 9, lines 51-67) which does not relate to the claimed invention. The rejection of claim 24 is respectfully traversed.

Claim 25 depends from claim 24 and further limits the claimed network. Walsh does not meet the limitations of claim 24 from which claim 25 depends. Therefore, Walsh certainly cannot meet the

limitations of claim 25. The rejection of claim 23 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

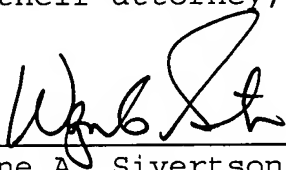
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Respectfully submitted,

Thomas N. Turba et al.

By their attorney,

Date Mar 3, 2006

  
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